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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,664	10/15/2001	Robert D. Herpst		3468
26009	7590	10/26/2006		
ROGER M. RATHBUN 13 MARGARITA COURT HILTON HEAD ISLAND, SC 29926			EXAMINER ALEXANDER, LYLE	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/977,664

**Applicant(s)**

HERPST, ROBERT D.

**Examiner**

Lyle A. Alexander

**Art Unit**

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20, 28,30-33,35-37 and 30-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 28,30-33,35-37 and 30-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20, 28,30-33,35-37 and 30-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims state the "solid, non-porous sample supporting substrate". However, the specification does not teach the claimed "solid, non-porous sample supporting substrate".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20, 28,30-33,35-37 and 30-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite what is intended by "solid, non-porous sample supporting substrate". It is not known what type of substrate is intended.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1-20, 28,30-33,35-37,30-44 and 46-53 are rejected under 35 U.S.C. 103(a) as being unpatentable Gagnon et al. (USP 5,764,355) in view of Eden et al. (USP 4,843,030), further in view of Applicants' admitted prior art (pages 3-8 of the original specification) or Izumi (USP 4,932,780).

See the appropriate paragraph of the 5/11/06 Office action.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gagnon et al. (USP 5,764,355) in view of Eden et al., further in view of Applicants' admitted prior art (pages 3-8 of the original specification) or Izumi (USP 4,932,780) together further in view of Marker et al. (4,855,110).

See the appropriate paragraph of the 5/11/06 Office action.

### ***Response to Arguments***

Applicant's arguments filed 8/14/06 have been fully considered but they are not persuasive.

Applicants' amendments deleting the language "has not been optically polished" has obviated the 5/11/06 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> paragraph rejections. However, the new claim language "solid, non-porous" has raised new 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> paragraph issues as elaborated above.

Applicants' state the "Examiner has not given any weigh" to the commercial success arguments. The Office has stated the 2/27/06 and 12/2/05 Affidavits are not sufficient to show commercial success of the instant invention as required by MPEP section 716.01.

Applicants' argue the Examiner is being placing too high a bar for Applicants' to show commercial success. The Office is constrained by the requirements set forth in MPEP section 716.01. Applicants' are encouraged follow the guidelines set forth by the MPEP to convincingly show commercial success.

Applicants' state new claim language "solid, non-porous" is supported by the original specification disclosure of a crystal. The Office does not understand how the instant claim language "solid, non-porous" is supported by the taught crystal structure.

Applicants' state on page 19 in the second full paragraph, the Office has relied on the first embodiment taught by Gagnon et al. Applicants' state the instant invention is created by very specific production steps. These remarks are not commensurate in scope with the instant claims as none of these steps are claimed. Also, Applicants' remarks that Gagnon et al. do not teach "solid, non-porous sample supporting substrate" are not commensurate in scope as these limitations appear to be new matter (see the above 35 USC 112 1<sup>st</sup> paragraph rejections).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lyle A Alexander  
Primary Examiner  
Art Unit 1743